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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,634	02/25/2002	Viktor Magdolen	100564-00104	1915

6449 7590 12/17/2003

ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
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WASHINGTON, DC 20005

EXAMINER

KUMAR, SHAILENDRA

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/049,634

Applicant(s)

MAGDOLEN ET AL.

Examiner

SHAIENDRA - KUMAR

Art Unit

1621

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

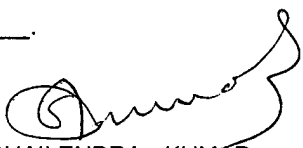
3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 19, 25, 27-29, 35, 42, 84-88 and 90-95.Claim(s) objected to: 18, 25, 48, 49, 51-83 and 96-98.Claim(s) rejected: 15, 16, 23, 24, 30-34, 36-41, 43-50 and 89.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see the supplementary note.

  
SHAIENDRA - KUMAR  
Primary Examiner  
Art Unit: 1621


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This office action is in response to applicants' communication filed in paper # 9, on 10/31/03.

Applicants' request to withdraw the finality of the office action of paper # 8, is **hereby denied**.

Applicants argue that Honda reference was applied for the first time in the office action of paper # 8. This is true. But, the reference was not applied in the office action of paper # 5, because the claims were claiming non statutory subject matter in terms of "use" language and claims were properly rejected under 35 USC 112 2<sup>nd</sup> paragraph and 35 USC 101.

Claims 15-16, 23-24 and 30-37 are again rejected under 35 USC 103 as obvious over Honda et al, for the reasons of record. Applicants' amendment, which will be entered, upon filing the notice of appeal, still renders claims obvious, as positional isomers are prima facie obvious as a whole. In re Wiechert (CCPA 1967) 370 F2d 927, 152 USPQ 247.

  
SHAIENDRA KUMAR  
PRIMARY EXAMINER  
GROUP 1200  
1621